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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,242	06/12/2002	Hideki Kirino	967 030	4548
20874	7590	09/26/2008	EXAMINER	
MARJAMA MULDOON BLASIAK & SULLIVAN LLP			SMITH, CHENEA	
250 SOUTH CLINTON STREET				
SUITE 300			ART UNIT	PAPER NUMBER
SYRACUSE, NY 13202			2623	
			MAIL DATE	DELIVERY MODE
			09/26/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/089,242	KIRINO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	CHENEA P. SMITH	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 11 June 2008.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,2,4,6,9-12,14,17,18,20,23 and 24 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,2,4,6,9-12,14,17,18,20,23 and 24 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 12 June 2002 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 7/26/02.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group (b) in the reply filed on 6/11/2008 is acknowledged. The traversal is on the ground(s) stated on pages 7-8 of Applicants' arguments.

This is not found persuasive because the communications mailed on 5/13/2008 was in regards to an election of species. Therefore, the requirements of MPEP §817(A) do not apply. In addition, Applicants should also note page 2, line 12 – page 3, line 9 in the communication mailed on 5/13/2008:

*“The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.*

*Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.*

*There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries), and/or the prior art applicable to one species would not likely be applicable to another species, and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.*

*Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.”*

For clarification, the species require a different field of search (e.g., Species (a), which may be searched in classes 725/79, 725/124-125, 178 and 348/470 Species (b), which may be searched in classes 725/81, 340, 342, 343, 348 and 455 Species (c), which may be searched in classes 725/20, 348, 386 and Species (d), which may be searched in classes 725/149 and 455).

Applicants’ arguments are also not found persuasive because “no telephone communication need be made where the requirement for restriction is complex, the application is being prosecuted by the applicant pro se, or the examiner knows from past experience that an election will not be made by telephone” , as stated in MPEP §812.01. In this case, it has been the Examiner’s past experience that applications with foreign priority typically require the applicants’ representatives to contact foreign applicants for approval, and a response would not be made by telephone within a reasonable amount of time.

The requirement is still deemed proper and is therefore made FINAL.

Regarding Applicants’ arguments on page 7, lines 1-5, in which Group (b) is provisionally elected, with the claims directed to Species (b) being 1-2, 4, 6, 9-12, 14, 17 -18, 20-21 and 23-24, the Examiner disagrees with the Applicants’ assertion that claim 21 is directed to Species (b). It appears to the Examiner that claim 21 is directed towards Species (c), and is

therefore withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species.

2. Claims 3, 5, 7-8, 13, 15-16, 19 and 21-22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 6/11/2008. Claims 1-2, 4, 6, 9-12, 14, 17-18, 20 and 23-24 are pending in this action.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2, 4, 6, 9-12, 14, 17-18, 20 and 23-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Kirino et al. (US7209746, hereinafter Kirino).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37

CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Regarding claims 1, 10-11, 18 and 23, Kirino discloses a transmission system comprising:

a transmission device (transmission apparatus 101, see Fig. 4) for receiving a list of frequencies (see col 15, lines 30-36) that are judged to be unlikely to cause mutually detrimental disturbance between themselves and the other users who are allowed to use a TV broadcast frequency spectrum (see col 15, lines 1-5 and col 17, lines 24-29) by a public institution (see col 1, lines 28-33), and

transmitting a digital modulated wave using frequency in the frequency list (see col 15, lines 46-58), and

a reception device (receiving apparatus 117, see Fig. 4) for receiving the digital modulated wave transmitted from the transmission device (see Fig. 4).

Regarding claims 2 and 12, Kirino discloses the transmission device does not transmit the digital modulated wave when the frequency list is not updated within a previously defined period (does not transmit when the list is not updated, the predetermined time being the time it takes for the frequency list to be updated, see col 24, lines 62-67 and col 25, lines 1-12).

Regarding claims 4, 14 and 20, Kirino discloses the transmission device transmits the digital modulated wave through the air via radio waves, and the reception device receives the digital modulated wave transmitted through the air (see Fig. 4).

Regarding claim 6, Kirino discloses a plurality of the reception devices (transmission/reception apparatuses 201A and 201B, see col 19, lines 14-17).

Regarding claims 9 and 17, Kirino discloses the transmission device and the reception device perform transmission and reception of the digital modulated wave in the same building (see col 1, lines 28-33).

Regarding claim 24, Kirino discloses a transmission reception system (see Fig. 4) comprising:

a frequency list sending device (receiving apparatus 117, see Fig. 4) for sending (see col 15, lines 30-36) a list of frequencies (see col 15, lines 30-36) that are judged to be unlikely to cause mutually detrimental disturbance between themselves and the other users who are allowed to use a TV broadcast frequency spectrum (see col 15, lines 1-5 and col 17, lines 24-29) by a public institution (see col 1, lines 28-33),

a transmission device (transmission apparatus 101, see Fig. 4) for receiving the frequency list (see col 15, lines 30-36) and transmitting a digital modulated wave using frequency in the frequency list (see col 15, lines 46-58), and

a reception device (receiving apparatus 117, see Fig. 4) for receiving the digital modulated wave transmitted from the transmission device (see Fig. 4),

wherein the transmission device does not transmit the digital modulated wave when the frequency list is not updated within a previously determined period (does not transmit when the list is not updated, the predetermined time being the time it takes for the frequency list to be updated, see col 24, lines 62-67 and col 25, lines 1-12).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHENEA P. SMITH whose telephone number is (571)272-9524. The examiner can normally be reached on Monday through Friday, 7:30 am - 5:00 pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chenea P. Smith/  
Examiner, Art Unit 2623

/Christopher Grant/  
Supervisory Patent Examiner, Art Unit 2623